

REMARKS

Reconsideration and allowance of this application are respectfully requested.

Claims 1-16 remain pending. By this communication, claim 1 is amended.

Rejections Under 35 U.S.C. §112

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph for alleged indefiniteness. Applicants have amended claim 1 to address the Examiner's concerns and in a manner that does not affect the claim scope. Withdrawal of this rejection, therefore, is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Utsunomiya* (U.S. Patent No. 6,999,186) in view of *Kizaki* (U.S. Patent Publication No. 2003/0035142) and further in view of *Terajima* (U.S. Patent No. 5,309,251). Applicants respectfully traverse this rejection.

Despite the PTO's arguments to the contrary, Applicants maintain that the combination of *Utsunomiya*, *Terajima*, and *Kisaki* still do not establish a *prima facie* case of obviousness. In particular, the PTO has not shown that a rational basis exists for one of ordinary skill to combine the aforementioned references and achieve Applicants' claimed results.

Applicants' claims variously recite a device having, among other features, a detection unit and a controller, such that when input job image data is to be output multiple times and (i) if an expansion memory is mounted, the controller stores processed input job image data in a first storage destination memory for a second output session and beyond, and (ii) if the expansion memory is not mounted, stores the input job image data that is not processed in a second storage destination

memory for a second output session and beyond. Independent claims 1, 8, and 14 broadly encompass the foregoing features.

Upon careful analysis, Applicants respectfully submit that *Utsunomiya* fails to disclose or suggest a system having first and second destination memories as recited in Applicants' claims. Rather, this reference appears to be directed to a system in which image data for each input image is first stored in an input/output buffer 1032, rasterized and then stored in a rasterized image storage area 3008. Both the buffer 1032 and image storage area 3008 are contained within the same device 1037. See col. 5, line 58 through col. 6, line 32. *Utsunomiya* further discloses that an external memory 1043 is used when the buffer 1032 and/or storage area 3008 are full. See col. 6, lines 33-44.

The PTO acknowledges that *Utsunomiya* fails to disclose or suggest Applicants claimed detection unit and feature in which if an expansion memory is detected the first destination memory stores processed job image data and if an expansion memory is not detected the second destination memory stores image data that is not processed. The PTO relies on *Kizaki* and *Terajima* in an effort to remedy these deficiencies.

Kizaki discloses an image memory that includes primary and secondary memory devices (606, 607), where the primary and secondary memories store the same type of image data. See pgphs [0111], [0112], [0116], [0117], [0120], and [0131]. Because *Kizaki* discloses that both memory devices store the same data one of ordinary skill would not have had reason to look to this reference to remedy the deficiencies of *Utsunomiya*. As discussed above, *Utsunomiya* discloses a memory for storing input image data and another memory for storing rasterized

image data. As such, *Kizaki* appears to be cumulative with respect to this feature. Moreover, even if one of ordinary skill were to combine *Utsunomiya* with *Kizaki* for the use of a secondary memory, as hypothesized in the Office Action, the teachings of *Kizaki* are seemingly redundant to those of *Utsunomiya*, since the latter already discloses the use of an external memory to store image data when on-board memory is full. See col. 6, lines 33-44.

Terajima discloses a facsimile apparatus that enables an external memory to be detachably loaded. When a sensor detects that the external memory is loaded, a received communication is stored in the external memory. Alternatively, when the sensor does not detect the external memory, the received communication is stored in a RAM of the main body. The PTO asserts that this disclosure is analogous to Applicants' claimed detection unit that detects whether an expansion memory is mounted to a mounting unit. Even if this interpretation of *Terajima* were accurate, the deficiencies of *Utsunomiya* and *Kizaki* with respect to Applicants' claims are still not cured.

Integrating a sensor as described by *Terajima* into the alleged device of *Utsunomiya* and *Kizaki* would merely result in a system that stores image data and rasterized image data in an external memory based on whether the external memory is detected. As discussed above, *Utsunomiya* discloses a system that stores input image data in a buffer and input image data that has been rasterized in a rasterized storage area within the same memory device. A print job containing multiple copies can be output from either the buffer or the rasterized storage area, and an external memory is used when the initial memory device is full. *Kizaki* appears to disclose a

similar concept in which primary and secondary memory devices are used to store the same type (i.e., compressed) of image data.

The combination of *Utsunomiya* and *Kizaki* arguably disclose a concept in which input image data and processed (i.e., rasterized, compressed) input image data are stored in two memories. In the case of the primary reference *Utsunomiya*, rasterized image data is created and stored for each image to be output. Thus, despite whether an external memory is available, the concept described in *Utsunomiya* provides for storing rasterized (i.e. processed) image data in a second memory. As a result, Applicants' claimed embodiment is still not met by these references. Any other manner of integrating *Utsunomiya*, with the teachings of *Kizaki* and *Terajima* would seemingly destroy the operability of the primary reference.

In summary, *Utsunomiya*, *Kizaki*, and *Terajima* when applied individually or collectively fail to establish a *prima facie* case of obviousness, because not all features of Applicants' claims are disclosed. Applicants' remind the PTO that the Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal

conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added). Withdrawal of this rejection is respectfully requested.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1-17 are allowable, and this application is in condition for allowance. Accordingly, Applicants request a favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicants request that the undersigned attorney be contacted at the number below.

Respectfully submitted,

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